

REMARKS

INTRODUCTION:

In accordance with the foregoing, claims 58-86 have been added, and claims 8-10, 12, 22, 29, 31, 48, 55, and 57 have been amended in accordance with 37 CFR §1.173 relative to the issued patent, U.S. Patent No. 5,819,002. Support for the changes in claims 8-10, 12, 29, 31, 48, 55, and 57 is found in, among other embodiments of the invention, the embodiment shown in FIG. 2B and described in col. 5, lines 25, in which a new reservation mode M2 is selected in sub-routine S17, a discriminating sub-routine S20 detects whether a current time has been set, and if the current time is set in sub-routine S22, the new reservation mode M2 is retrieved in sub-routine S23. Support for the new claims 58-86 is found in the embodiment shown in FIGs. 2A and 2B, which show subroutines performed by a microprocessor 10 and which are stored in the ROM as shown in FIG. 1 and described in col. 2, lines 43-47 and col. 4, line 16 through col. 5, line 35.

No new matter is being presented, and approval and entry of the foregoing amendments and new claims are respectfully requested.

Claims 1-86 are pending and under consideration. Reconsideration is requested.

CONFIRMATION AS TO WITHDRAWAL OF FINALITY:

In the Office Action at page 1, the Examiner indicated that the Office Action was *Final*. Pursuant to the discussion with the Examiner and the Letter to the Examiner filed August 25, 2003, the Examiner provided on August 26, 2003 a corrected page 1 of Office Action in which the action was labeled as non-final. Therefore, in accordance with the Examiner's correction, the outstanding Office Action is deemed a non final Office Action.

SUBMISSION OF ORIGINAL PATENT:

On page 2 of the Office Action, the Examiner notes that the original patent will need to be surrendered prior to the allowance of the application. Applicant respectfully submits that the original patent will be surrendered in compliance with 37 C.F.R. §1.178(a) on resolution of the Examiner's remaining outstanding objections and rejections as per MPEP 1416.

REJECTION UNDER 35 U.S.C. §102:

1. Rejection in view of Yuen et al.

In the Office Action at pages 2-4, the Examiner rejects claims 15, 21, 22, 28, 33, 43, 44, and 54 under 35 U.S.C. §102(b) in view of Yuen et al. (Canadian Patent No. 2005070). This

rejection is respectfully traversed and reconsideration is requested.

Among other features, the Examiner asserts that the G-code switch 22 described on page 5, line 25, of Yuen et al. automatically sets a current reservation mode to the one reservation mode in response to a request for a next timer reservation. As a point of clarification, Yuen et al. describes the G-code switch 22 as being used to manually lock in the G-code mode so as to allow entering G-codes. (Page 6, lines 6-9; FIGs. 1, 13, and 14 of Yuen et al.) However, while Yuen et al. suggests that the recorder remains in the G-code mode for as long as the G-code switch 22 is "on" so as to allow processing of additional G-codes, there is no suggestion that the mode is again set to the G-code mode when the next reservation is to be made. As such, assuming the last reservation was made using a G-code, Yuen et al. discloses no mechanism by which the G-code switch 22 is switched to the "on" position to allow entry of new G-codes unless the G-code switch 22 has been left in the "on" position or is manually switched to the "on" position. Therefore, where the last reservation was made in the G-code mode and the next reservation is to be made in the G-code mode, Yuen et al. requires the user to either maintain the G-code switch 22 in the "on" position, or manually switch the G-code switch 22 to the "on" position. However, since neither of these operations are performed except manually or through allowing the G-code switch 22 to merely remain in an existing position, neither of these operations can be fairly construed as automatically setting the G-code switch 22.

In contrast, claim 15 recites, among other features, "*automatically setting* a current reservation mode to the one reservation mode in response to a request for a next timer reservation." As such, it is respectfully submitted that Yuen et al. does not disclose or suggest the invention recited in claim 15.

For similar reasons, it is respectfully submitted that Yuen et al. does not disclose or suggest the invention recited in claims 22, 33, and 44.

Claims 21, 28, 43, and 54 are deemed patentable due at least to their depending from corresponding claims 15, 22, 33, and 44.

2. Rejection in view of Beyers, Jr.

In the Office Action at pages 4-5, the Examiner rejects claims 29-32 and 55-58 under 35 U.S.C. § 102(b) in view of Beyers, Jr. (U.S. Patent No. 4,641,205). This rejection is respectfully traversed and reconsideration is requested.

By way of review, Beyers, Jr. discloses a method of scheduling a program to be recorded in which a flag is checked to determine if power was lost. If power was lost, the clock must be set before a program can be scheduled. If the user is to reserve a program, the user is thus

required to first input the current time. (Col. 7, lines 39-68, col. 8, lines 23-33; operations 005, 007, 012, 020 through 032 of FIGs. 4a, 4b of Beyers, Jr.) Once the current time has been input, the user is allowed to proceed to the operations shown in FIG. 4d, whereby the user is able to reserve the schedule the program to be recorded using the current time. (Col. 9, line 36 to col. 11, line 50; operations 012, 013, 015, 017 of FIGs 4b and 4d of Beyers, Jr.) However, there is no suggestion that the user is able to schedule the program prior to setting the clock, that the recording mode is selected, or that other recording modes can be selected.

In contrast, claim 29 recites, among other features, "automatically shifting to a time adjusting mode for enabling a user to enter the current time if the current time has not been set," and "performing the timer reservation subsequent to the current time having been set or entered by the user according to a stored reservation mode selected and stored before the current time was set." As such, it is respectfully submitted that Beyers, Jr. does not disclose or suggest the invention recited in claim 29.

It is respectfully submitted that Beyers, Jr. does not disclose or suggest the invention recited in claim 57.

Similarly, since Beyers, Jr. does not suggest multiple recording modes, it is respectfully submitted that Beyers, Jr. further does not disclose or suggest "performing the timer reservation subsequent to the current time having been entered by the user according to a stored reservation mode stored and selected from one of a plurality of reservation modes usable by the recording and/or reproducing device before the current time was entered" as recited in claim 31.

It is respectfully submitted that Beyers, Jr. does not disclose or suggest the invention recited in claim 55.

Claims 30, 32, 56, and 58 are deemed patentable due at least to their depending from corresponding claims 29, 31, 55, and 57.

REJECTION UNDER 35 U.S.C. §103:

1. Rejection in view of Yuen et al.

In the Office Action at pages 5-6, the Examiner rejects claims 39, 40, 48, 50, and 51 under 35 U.S.C. §103 in view of Yuen et al. and the Examiner's taking Official Notice that volatile and non-volatile memories are well known. The rejection is respectfully traversed and reconsideration is requested.

Assuming arguendo that the combination is correct, it is noted that the Examiner's taking Official Notice of the existence of volatile and non-volatile memories does not cure the above noted deficiencies of Yuen et al. as applied to claims 33 and 44 as described above. As such, it

is respectfully submitted that the combination of Yuen et al. and the Examiner's taking Official Notice does not disclose or suggest the invention recited in claims 39, 40, 48, 50, and 51 due at least to the combination not disclosing or suggesting the invention recited in claims 33 and 44 from which claims 39, 40, 48, 50, and 51 correspondingly depend.

Lastly, even assuming *arguendo* that, consistent with the Examiner's assertions, both volatile and non-volatile memories are well known mechanisms for storing data, it is noted that Yuen et al. does not rely upon, or express a need for using, memories in order to utilize the G-mode. Instead, Yuen et al. suggests using the G-code switch 22. As such, there does not appear to be any evidence in the prior art of a motivation to utilize either volatile or non-volatile memories in order to store a recording mode.

As noted by MPEP 2143.01, an unsubstantiated statement that existing elements could be combined as it was in the skill of the art to do so does not provide a basis for a rejection under 35 U.S.C. 103(a). Instead, in order to establish a *prima facie* case for obviousness, the rejection must detail the existence of the individual elements at the time of invention, that there was an existing motivation to combine these elements contained in the then existing art, and that this motivation is beyond an unsupported statement that the combination of these elements was within the skill of the art. In essence, there needs to be proof that such a motivation exists, not conjecture. This rigorous proof is required in order to prevent the trap of impermissible hindsight. As such, even assuming *arguendo* that the Examiner is correct, it is respectfully submitted that the Examiner has not provided sufficient evidence from the prior art of record that one of ordinary skill in the art would have used either a volatile or non-volatile memories in the device disclosed in Yuen et al. as is required to maintain a rejection of claims 39, 40, 48, 50, and 51 under 35 U.S.C. §103.

2. Rejection in view of Yuen et al. and Beyers, Jr.

In the Office Action at pages 6-8, the Examiner rejects claims 8, 9, 20, 27, 38, and 49 under 35 U.S.C. §103 in view of Yuen et al. and Beyers, Jr. The rejection is respectfully traversed and reconsideration is requested.

As an initial point, since the Examiner does not rely on Beyers, Jr. as curing the above-noted deficiency of Yuen et al. as applied to claims 15, 22, 33, and 44, it is respectfully submitted that the combination of Yuen et al. and Beyers, Jr. does not disclose or suggest the invention recited in claims 20, 27, 38, and 49, which correspondingly depend from claims 15, 22, 33, and 44.

Moreover, assuming *arguendo* that the combination is correct, it is noted that, as also noted above with respect to the rejection of claims 15, 22, 33, and 44, Yuen et al. does not

disclose or suggest, among other features, "an automatic reservation mode setting operation in a reservation mode which memorizes a last reserved reservation mode, and automatically sets a current reservation mode to the memorized reservation mode at a next reservation" as recited in claim 8. Instead, while Yuen et al. discloses scheduling a recording according to a state in which the G-code switch 22 is left, and Yuen et al. does not suggest that the G-code switch 22 is set when a new G-code is to be entered unless the setting is done by the user.

As such, since the Examiner does not rely on Beyers, Jr. as disclosing such a feature, it is respectfully submitted that the combination of Yuen et al. and the Examiner's taking Official Notice does not disclose or suggest the invention recited in claim 8.

Claim 9 is deemed patentable due at least to its depending from claim 8.

STATUS OF CLAIMS NOT REJECTED:

On page 9 of the Office Action, the Examiner allows claims 1-7 and 11-14 and objects to claims 10, 16-19, 23-26, 34-37, 41, 42, 45-47, 52, and 53 for depending from rejected claims.

ATTACHMENT SHOWING AMENDMENTS:

While not required under 37 CFR §1.173, please find enclosed a Version With Markings To Show Changes Made, which is provided for the convenience of the Examiner. The changes are relative to the reissue application, as filed.

PATENTABILITY OF NEW CLAIMS:

Claims 59-81 are deemed patentable for reasons similar to why claims 8-29 are deemed patentable as set forth in detail above. Moreover, new claims 60-62, 64-66, 68-73, 75-80, and 82-86 are further deemed allowable due at least to their depending from corresponding claims 8, 15, 22, 33, 44, 59, 63, 67, and 74.

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, it is respectfully submitted that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview

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to discuss resolution of such issues.

If there are any additional fees associated with the filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Please **AMEND** claims 8-10, 12, 22, 29, 31, 48, 55, and 57, as follows:

8. (ONCE AMENDED) A method of setting a timer reservation in a device having a plurality of reservation modes, the method comprising:

an automatic reservation mode setting operation in a reservation mode which memorizes ~~the~~a last reserved reservation mode, and automatically sets a current reservation mode to the memorized reservation mode at ~~the~~a next reservation; and

an automatic time adjustment implementing operation which shifts to a time adjusting mode where ~~the~~a current time may be set by a user upon inputting a reservation key and upon selecting a reservation mode, when the current time has not been set.

9. (ONCE AMENDED) The method as claimed in claim 8, wherein said automatic reservation mode setting operation comprises:

a reservation mode fetching operation sub-operation which fetches the memorized reservation mode; and

a reservation mode implementing sub-operation which automatically reserves the fetched last reservation mode and stores the reserved reservation mode as the last reservation mode after the completion of the reservation.

12. (ONCE AMENDED) The method as claimed in claim 11, further comprising automatically shifting to a time adjusting mode for setting ~~the~~a current time when the current time is not already set.

22. (ONCE AMENDED) A method of setting a timer reservation in a ~~reproducing~~-device having a plurality of reservation modes, wherein a last one of the reservation modes in which a last timer reservation was performed has been stored, the method comprising:

receiving a request for a next timer reservation; and

automatically setting a next reservation mode to the last reservation mode in response to the request for a next timer reservation.

29. (ONCE AMENDED) A method of setting a timer reservation in a device, the method comprising:

receiving a request for the timer reservation;
 checking whether a current time has been set before performing the timer reservation;
 automatically shifting to a time adjusting mode for enabling a user to enter the current time if the current time has not been set; and
 performing the timer reservation subsequent to the current time having been set or entered by the user according to a stored reservation mode selected and stored before the current time was set.

10. (ONCE AMENDED) The method as claimed in claim 8, wherein said automatic time adjustment mode implementing operation comprises:

a reservation mode selecting sub-operation which displays a menu when said automatic reservation setting mode operation has not set the memorized reservation mode in response to another input from the user for another reservation mode and when a reservation mode is selected from said menu, thereafter storing the selected mode;

a time adjustment mode implementing sub-operation which automatically advances to a time adjusting mode to set the current time upon finding that the current time has not been set; and

a memorized reservation mode implementing sub-operation which fetches the reservation mode stored at said reservation mode selecting sub-operation, and performs the fetched reservation mode and stores the reserved reservation mode as the last reservation mode.

31. (ONCE AMENDED) A method of setting a timer reservation in a recording and/or reproducing device, the method comprising:

automatically shifting to a time adjusting mode for enabling a user to enter the current time if the current time has not been set in response to a request for a timer reservation; and

performing the timer reservation subsequent to the current time having been entered by the user according to a stored reservation mode stored and selected from one of a plurality of reservation modes usable by the recording and/or reproducing device before the current time was entered.

48. (ONCE AMENDED) The device as claimed in claim 44, wherein the processor comprises a [read only] memory which stores whichever of the last reservation mode and the user selected reservation mode is used to perform the next timer reservation as a new last

reservation mode in response to the performing of the next timer reservation.

55. (ONCE AMENDED) A device, comprising:

an input device receiving a request for a timer reservation;

a memory in which is stored a reservation mode selected from a plurality of reservation modes usable by the device; and

a processor checking whether a current time has been set before performing the timer reservation, automatically shifting to a time adjusting mode for enabling a user to enter the current time to the input device if the current time has not been set, and performing the timer reservation subsequent to the current time having been set or entered by the user to the input device according to the stored reservation mode stored in the memory prior to the current time having been set or entered.

57. (ONCE AMENDED) A device, comprising:

a processor automatically shifting to a time adjusting mode for enabling a user to enter the current time if the current time has not been set in response to a request for a timer reservation, and performing the timer reservation subsequent to the current time having been entered by the user according to a stored reservation mode recalled from a memory and which was stored prior to the current time having been entered.